

Applicant : Shackleford  
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Serial No. : 10/078,618  
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### REMARKS

Applicant wishes to thank the Examiner for withdrawing objections to both the drawings and specifications. In addition, Applicant also appreciates the Examiner's withdrawal of previous rejections under 35 USC 101 and 35 USC 102(e) in view of L'Heureux et al. (U.S. Pat. 6,697, 942).

In the Request for Continued Examination (RCE) filed herewith, Applicant respectfully requests reconsideration of the remaining rejection of claims 1-3, 5-7, 10-14, 18-20, 25, and 26 under 35 U.S.C § 102(e) in light of Fleming et al., (US Pat. 6,625,444). Provided the current remarks and claims as amended, Applicant believes these claims to be in condition for allowance.

Applicant respectfully submits that the Examiner has failed to establish the prima facie case as each and every element of independent claims 1-3, 5-7, 10-14, 18-20, 25, and 26 are not taught by Fleming. See Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2D (BNA) 1913, 1920 (Fed. Cir.), cert. denied, 493 U.S. 853, 107 L. Ed. 2d 112, 110 S. Ct. 154 (1989) (explaining that an invention is anticipated if every element of the claimed invention, including all claim limitations, is shown in a single prior art reference). See Jamesbury Corp. v. Litton Industrial Products, Inc., 756 F.2d 1556, 1560, 225 USPQ 253, 256 (Fed. Cir. 1985) (explaining that the identical invention must be shown in as complete detail as is contained in the

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patent claim). See *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 U.S.P.Q.2D (BNA) 1051, 1053 (Fed. Cir. 1987) (explaining that a prior art reference anticipates a claim only if the reference discloses, either expressly or inherently, every limitation of the claim). See *Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 1571, 230 U.S.P.Q. (BNA) 81, 84 (Fed. Cir. 1986) ("Absence from the reference of any claimed element negates anticipation.")

Fleming describes storing a phone number in a phone found through a directory assistance system (DAS) (Col. 4, lines 24-30 of Fleming). More specifically, Fleming's requirements include "verbally providing entity information to the DAS" (See FIG. 4, FIG. 5, FIG. 6 and corresponding text Col. 4, lines 9-11; Col. 4, lines 53-55; Col. 4, lines 64-65; Col. 5, lines 10-12). In other words, Fleming requires a person to make a phone call to the DAS (i.e., dial 411 or the equivalent) and then verbally request a phone number and address. Clearly, this cannot qualify Fleming as teaching or even suggesting claim 1 without hindsight reconstruction of the invention. See *In Re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir 1988) ("One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention") *Grain Processing Corp. v American Maize-Products Corp.*, 840 F. 2d 902, 5 USPQ2d 1788 (Fed. Cir 1988) ("Care must be taken to avoid hindsight

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reconstruction by using 'the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit.'")

Applicant respectfully points out that Fleming does not generate "an electronic mail message in response to data entered by a user, the electronic mail message including user-selected preference data for the electronic system" as recited in claim 1. Instead, Fleming requires a phone call to be made and a verbal request for a phone number. Making a verbal request is not equivalent to data entry by a user. For at least this reason alone, Fleming does not anticipate Claim 1 as amended.

Technology and processing designed to facilitate voice communication and interpretation is not the same as that used for data communication. Indeed, voice can be carried over a data network but this still does not make these different modalities the same for 102(e) purposes in this instance. For example, it is possible to carry voice over specialized voice over IP or VOIP technology. The VOIP technology allows voice to be carried over data networks but they remain fundamentally different from a data processing standpoint.

Of the many differences that exist, the voice signal data passing over either VOIP enabled data lines or even plain old telephone service (POTS) still needs a person or voice recognition software to interpret the spoken language. In contrast, data entered by a user as

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recited in claim 1 refers to digital data that passes over a data network as digital information for immediate use and without further voice processing. For at least this reason, the Examiner cannot equate a voice request made over a telephone as described in Fleming as the same or even equivalent to a data request.

Further, Fleming does not “automatically extract the user-selected preference data from the electronic mail message” as recited in claim 1. Instead, Fleming looks this information up in a database of the DAS and sends the results to a phone. Fleming is inflexible as the data is limited to information that is already located in the DAS and does not include user-selected preference data entered by the user. The user looks up and parses out a telephone number and alphanumeric identifier (Col. 5, lines 4-6 of Fleming) vis a vis Fleming because he/she does not know the phone number. For example, Fleming suggests verbally specifying the name of a person and in return receives a phone number from the database. Unfortunately, the phone number returned from the database is not user-selected but data the user is seeking to discover.

Indeed, Fleming does not teach or suggest, “configuring the electronic system with the user-selected preference data to modify operation of the electronic system” as recited in amended claim 1. For example, Fleming is limited to merely storing a phone number and possibly an address in a phone as that is all a DAS is capable of providing (Summary of the

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Invention/Col. 2, lines 1-22, Claim 1 and Col. 3, lines 13-33 of Fleming). Consequently, for at least this additional reason Fleming does not anticipate claim 1.

Accordingly, claim 1 is in condition for allowance in view of Fleming. While dependant claims 2-9 are allowable on their own, they are also in condition for allowance based upon their dependency of claim 1 as well.

Independent claims 10, 18, 25 and 26 are also in allowance for at least the same reasons as claim 1 described above. Corresponding dependant claims 11-17, 19-24 are allowable on their own but also in condition for allowance by virtue of their dependency on their parent claims.

Examiner also rejected claims, 4, 8, 9, 15-17, and 21-24 under 35 USC 103(a) over Fleming and further in view of Brown (US Pat. No. 6,625,444).

First, Applicant respectfully submits that claims 4, 8, 9, 15-17, and 21-24 are patentable as they depend from claims that are patentably distinct over the cited art. "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." *In re Fine*, 837 F.2d 1071, \_\_\_, 5 USPQ2d 1596 (Fed. Cir. 1988).

Nonetheless, the Examiner has provided no express, implied or inherent motivation or suggestion to combine Fleming with Brown. Examiner has made no attempt to provide any credible suggestion or motivation to combine the teaching of directory assistance in Fleming

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with transcoding electronic mails in different formats from Brown. ("To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaack , 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)).

In this case, the Examiner contends that Brown is "In a related art of e-mail communication" thus justifying combining Brown with Fleming. Unfortunately, the test is *not* whether two different items cited by the Examiner are "related art" but whether there is a suggestion or motivation to combine. Clearly, the Examiner has failed to properly combine these references as required. Because the Examiner has made no attempt to provide a proper justification for combining these references then the corresponding rejection under 35 USC 103(a) should be removed. For this additional reason, claims, 4,8, 9, 15-17, and 21-24 remain allowable subject matter.

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Claims 1-26 are now in condition for allowance. Claims 1-26 are neither taught nor suggested by Fleming or Brown alone or combination.

Applicants have made a diligent effort to place the claims in condition for allowance. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Leland Wiesner, Applicants' Attorney at (650) 853-1113 so that such issues may be resolved as expeditiously as possible.

For these reasons, and in view of the above amendments, this application is now considered to be in condition for allowance and such action is earnestly solicited.

Respectfully Submitted,



\_\_\_\_\_  
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